

09/599,051

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Michael J Witz et al.	Examiner:	Daniel Kesack
Serial No.:	09/599,051	Group Art Unit:	3624
Filed:	June 21, 2000	Docket:	2043.197US1
Title:	COMMUNITY BASED FINANCIAL PRODUCT		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

REMARKS

This responds to the Office Action mailed on September 25, 2006.

Claims 1-12 are presently pending in this application.

§102 Rejection of the Claims

Claims 1-3 were rejected under 35 U.S.C. § 102(e) for anticipation by Reese (U.S. 6,236,980). It is of course fundamental that in order to sustain an anticipation rejection that each and every step or element in the rejected claims must be taught or suggested in the cited reference.

More specifically, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently in a single reference. *Verdegaal Bros.v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 1051, 1053 (Fed. Cir. 1987). Additionally, “[t]he identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

Applicants would like to respectfully reiterate that anticipation is only proper if “[t]he identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989).

Fundamentally, the Examiner has asserted that the limitation: “wherein the preference

from the user is a selection of an investment or an allocation for the investment that the user provides to the virtual community,” which is included in independent claim 1, is taught in Reese at column 12 lines 11-16, 35-38, and FIG. 7. Applicants respectfully disagree.

The entire teaching of Reese is directed to an automated service that scans existing publications to summarize them and to make investment recommendations. There is no concept of or ability a “preference from a user” to be “a section of an investment or an allocation for the investment that the user provides to the virtual community.” The Examiner’s attention is specifically directed to column 12 lines 26-33. Here, the context of the prior remarks of Reese are brought into focus; namely, Reese’s system predetermines investment sources and scans them to make recommendations. There is no teaching or even an ability in Reese where the “preference from a user” is a “selection of an investment or an allocation for the investment that the user provides to the virtual community.”

Column 6 lines 27-36 specifically defines who is recommends particular investments. These are authors of investment publications that are scanned and analyzed and pre-chosen by Reese’s system. The user in Reese (column 2 lines 51-54) is not make recommendations to anyone in the Reese system. The user is a passive observer that benefits from the supposed expertise and data mining performed by Reese on behalf of the user from investment sources having experts that produce articles about recommended securities. In fact, the stated objects of Reese identified in columns 2-3 clearly teach the passive nature of the user in the Reese system.

Reese is not a virtual community that is capable of promoting egalitarian investment knowledge from the masses of individual users; Reese is a knowledge system that makes investment decisions based on mining investment sources and the those decisions result in recommendations that are pushed to the users. Claim 1 clearly cites a limitation that it is a user within a virtual community that makes an investment selection or allocation to a virtual community. This limitation is not the approach that Reese uses. Reese does not allow users to make selections or allocations to a virtual community. Reese uses a canned algorithm and pre-selected investment sources to decide on selections that are proposed and pushed to the users.

Reese uses the terms and phrases “user,” “recommenders, (sic)” and “recommendation sources” in consistent manners. A user is clearly not a recommender (sic) in Reese. There is no ability for a user to be a recommender (sic). The fact that the Examiner states that the writers of

magazine articles are users is not a permissible interpretation because Reese has clearly delineated the distinction between “users” and “recommenders (sic)” and does not commingle the usage. A user in Reese is not a recommender (sic) the fact that the Examiner states it could be is in direct contradiction to the actual teachings of Reese and is therefore not permissible.

Additionally, Applications continue to respectfully maintain that there is no teaching of “deriving a financial product” in Reese. In the prior action the Examiner cited column 2 line 40 through column 3 line 54 for this teaching. This reference merely illustrates that it is the user that digest the summarized information to make a selection for an investment. In fact, Reese does not even make a selection it merely summarizes sources in a format that the user can digest to select one. There is no derivation of a financial product. It is up to the user to digest the information and make a determination on a selection. Reese does not derive any financial product.

It appears that the Examiner has to rely on a number of tenuous interpretations of the Reese reference to arrive at the claimed invention. These interpretations distort the very teachings of Reese because Reese is clearly being used to teach analyzing pre-selected publications to summarize investment information that a user digests to make a selection. Reese does not permit recommenders (sic) to be users and does not let a user make a selection of an investment. Moreover, Reese does not derive a financial product; rather, Reese lets a user select an investment after the user decides based on information summarized. The manner in which the Examiner wants to interpret Reese to reject the claims distorts the very fundamental teachings and purpose of the Reese reference. Applicants respectfully believe that this is not appropriate and is not permissible especially in an anticipation scenario, because anticipation is only proper if “[t]he identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989).

Accordingly, Applicants submit that Reese fails to teach or suggest each and every step or element in the rejected independent claim 1. Therefore, the rejections are not sustainable and should be withdrawn. Applicants respectfully request an indication of the same.

§103 Rejection of the Claims

Claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese.

Claims 8-12 are dependent from amended independent claim 1; therefore for the amendments and remarks presented above with respect to claim 1, the rejections of claims 8-12 should be withdrawn. Applicants respectfully request an indication of the same.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Segal et al. (U.S. 6,049,783). Claims 4-5 are dependent from amended independent claim 1; thus for the amendments and remarks presented above with respect to claim 1, the rejections of claims 4-5 should be withdrawn. Applicants respectfully request an indication of the same

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claim 1 above, and further in view of Phillips et al. (U.S. 6,473,084). Claim 6 is dependent from amended independent claim 1; therefore, for the amendments and remarks presented above with respect to claim 1, the rejections of claim 6 should be withdrawn. Applicants respectfully request an indication of the same

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Wallman (U.S. 6,338,047). Claim 7 is dependent from amended independent claim 1; thus, for the amendments and remarks presented above with respect to claim 1, the rejections of claim 6 should be withdrawn. Applicants respectfully request an indication of the same.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

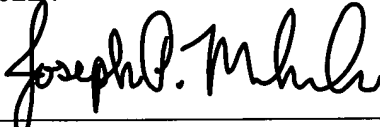
Respectfully submitted,

MICHAEL J WITZ ET AL.

By their Representatives,

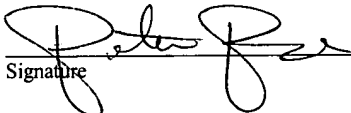
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Date November 30, 2006

By / 
Joseph P Mehrle
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30 day of November 2006.

Name Peter Rebuffoni


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